



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: §
Kontonassios §
Application No.: 09/824,255 §
Date Filed: 04/02/2001 §
Title: Method and Apparatus for Displaying §
And Manipulating Account §
Information using the Human Voice §

Group Art Unit: 2654

Examiner: Martin Lerner

Atty Docket No.: 19002/0003

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PATENT TRADEMARK OFFICE

Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO THE OFFICE ACTION DATED JULY 22, 2004

The office action of July 22, 2004 included an objection to the specification, a rejection alleging claims are unpatentable over Holzman et al. (6,347,299) in view of Mitchell et al. (5,857,099)¹, and a rejection alleging claims are unpatentable over Holzman et al. in view of Mitchell et al. and further in view of Hon et al. (6,490,563)². Below, Applicant responds to the objection and rejection, and respectfully requests Examiner's reconsideration in light of Applicant's responses.

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¹ Office Action of July 22, 2004 at 3-6, issued against Kontonassios, *Method and Apparatus for Displaying and Manipulating Account Information Using the Human Voice* (Application, United States Serial Number 09/824,255, Filed April 02, 2001)(Atty. Docket No. 19002/0003)

² *Id.* at 6-7

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OBJECTION

APPLICANT SUBMITS A SUBSTITUTE SPECIFICATION.

Applicant submits the attached substitute specification to correct minor spelling errors and address other minor informalities. The substitute specification is included as Exhibit 2 attached herein. Applicant also submits, as Exhibit 3, a marked-up copy of the substitute specification showing the matter being added to and the matter being deleted from the specification of record. No new matter is introduced by this update.

DISCUSSION

SUBSTITUTE SPECIFICATION ADDING NO NEW MATTER.

Applicant submits the enclosed substitute specification in accordance with 37 CFR 1.121. Entry is requested.

Exhibit 3 shows the spelling corrections made to the specification of record in accordance with the objection. No new matter is introduced by these updates.

RECORD OF TELEPHONE INTERVIEW

On October 20, 2004, the undersigned attorney for Applicant, W. Thomas Morrow, had a telephone interview with the examiner, Martin Lerner, to discuss the patentability of the claims in this case in view of the prior art. Attorney agreed with the specification objections set forth in the office action and informed the examiner that a substitute specification, introducing no new matter, would be submitted along with a request for entry. The remainder of the interview focused on the 35 USC §103 (a) rejections and the combination of Holzman in view of Mitchell with respect to the *prima facie* case for obviousness. Attorney agreed that the prior art references Holzman and Mitchell were from analogous art. Examiner then addressed the issue of the references teaching away from their combination. Examiner argued that even though Holzman taught that the invention should be practiced without a display, its suggestion that displays are used in working with electronic records was sufficient to avoid arguments regarding “teaching away.” Attorney argued that Holzman and Mitchell should not be combined because the proposed modification would render the prior art unsatisfactory for its intended purpose or change the principle of operation of the reference, making the teachings of the reference insufficient to render the rejected claims *prima facie* obvious.³ Examiner argued that *In re Gordon*⁴ was not on point because adding a display to Holzman by combination with Mitchell would not make the Holzman patent inoperable. Attorney then argued that Holzman and Mitchell should not be combined because the proposed modification or combination of the prior art would change the principle of operation of

³ MPEP §2143.01; *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

⁴ *Id.*

the prior art invention being modified, making the teaching of the references not sufficient to render the rejected claims *prima facie* obvious.⁵ Examiner argued that *In re Ratti*⁶ was not on point because the suggested combination of references would not require a substantial reconstruction and redesign of the Holzman patent to add a display to Holzman because displays were off the shelf items and well known in the art. Examiner suggested however that there was a significant amount of allowable matter in the application being examined and that amendment to the claims was available to the applicant to overcome the office action rejections.

Applicant has considered the Examiner's arguments and in the interest of efficient prosecution of this application and in an effort to adhere to the Commissioner's request for such efficiency, Applicant submits the present response to the office action dated July 22, 2004.

REJECTION

APPLICANT'S AMENDED CLAIMS ARE ALLOWABLE SUBJECT MATTER

Claims 8 to 10, 17 to 22, 33 to 40, and 46 to 54 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitation of the base claim and any intervening claims.⁷ Applicant submits attached Exhibit 3, with amended claims 8 to 10, 17 to 22, 33 to 40, and 46 to 54 rewritten in independent form. All other claims presented in Exhibit 3 depend from these previously objected to, currently amended claims and are therefore allowable over the prior art. Applicant submits the enclosed amended claims in accordance with 37 CFR 1.121. Entry is requested.

⁵ MPEP §2143.01; *In re Ratti*, 270 F.2d 810 (CCPA 1959)

⁶ *Id.*

⁷ *Office Action* at 7
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DISCUSSION

Claim 1 has been amended to include limitations from claim 8 similar to the limitations in objected to claim 33, claim 8 being previously dependent on claim 1 and objected to by Examiner in its dependent form. The limitation of a subwindow being a dictation area was left out of the amended claim 1 just as a similar limitation was not present in objected to claim 33. For these reasons, Claim 1 is allowable over the prior art.

Claims 2-6 are unchanged but depend from amended claim 1 that now contains allowable subject matter for the reasons expressed above. Claims 2-6 are allowable over the prior art.

Claim 7 is canceled.

Claims 8-12 depend from amended claim 1 and are therefore allowable.

Claims 13-16 depend from amended claim 12 and are therefore allowable.

Claims 17-22 are canceled and have been rewritten in their independent form as claims 58-63. Claims 58-63 are allowable over the prior art.

Claims 23-24 are dependent on amended claim 1. Claims 23-24 are allowable over the prior art.

Claim 25 has been amended to include the limitations of objected to claim 33. Amended claim 25 being rewritten as claim 33 in its independent form, is allowable over the prior art.

Claims 26-30 are unchanged but depend from amended claim 25 that now contains allowable subject matter for the reasons expressed above. Claims 26-30 are allowable over the prior art.

Claim 31 is canceled

Claims 32 and 34-38 depend from amended claim 25. Claim 32 and 34-38 are allowable over the prior art.

Claim 33 is canceled

Claims 39-40 are canceled and have been rewritten in their independent form as claims 64-65. For this reasons, Claims 64-65 are allowable over the prior art.

Claim 41 depends from amended claim 25 and claims 42 -44 depend from claim 41. Amended claim 25 being allowable, Claims 41-44 are also allowable over the prior art.

Claims 45-52 are canceled and rewritten in their independent form as claims 66-72. Claims 66-72 contains all the limitations of claims 46-52 including the limitations of any intervening claims and are allowable over the prior art.

Claims 53-54 are dependent from amended claim 25. For this reason, Claims 53-54 are allowable over the prior art.

Claim 55 is unchanged. Claim 55 was allowed in the first office action.

Claims 56-57 are new claims that depend from amended claim 1. Claims 56-57 are allowable over the prior art since they depend from an allowable claim.

CONCLUSION

For the foregoing reasons, and for other reasons clearly apparent, allowance of the application is respectfully requested.

If there are matters which can be discussed by telephone to further the prosecution of this application, Applicant respectfully requests that the Examiner call Applicant's attorney at the telephone number listed herein below.

The Commissioner is hereby authorized to charge or credit any additional fees required or overpaid to the credit card account specified in the credit card payment form submitted with this response.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "W. Thomas Morrow", is written over a horizontal line.

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Date: October 22, 2004